

claim the subject matter which applicant regards as the invention. Claim 20 effectively incorporates the limitation of claim 25 (now cancelled) therein, while claim 27 now defines first and second drying means used to preliminarily and non-preliminarily dry the strippable paint. Claims 26 and 30 have been amended to be consistent with amended claims 20 and 27; and dependent claims 22-25, 28 and 29 have been cancelled. Additionally, applicant has added new claim 37 further defining features of claim 32.

Applicant respectfully submits that all of the above amendments are fully supported throughout the original application.

In the Office Action claim 20, 22, and 24-33 (all of the claims in the application still under consideration by the Examiner) stand rejected under 35 USC §103(a) as being unpatentable over applicant's admitted prior art as defined in the specification in view of Tomioka et al. (U.S. Patent 5,428,880). It is the Examiner's position that the "Description of the Related Art" on pages 1-4 of the specification discloses a prior art method very similar to that being claimed except that such prior art method fails to literally disclose that the automobile is assembled after it has been painted; that it would have otherwise been obvious to one of ordinary skill in the art to assemble the automobile after painting it in view of Tomioka; that it would also have been obvious to one skilled in the art to coat strippable paint onto a painted automobile in order to realize the benefits that a strippable paint exhibits relative to a rust preventive wax as discussed at page 1, lines 17-21 and page 2, lines 7-8 in the specification; that "[r]egardless, when the strippable paint is applied relative to the assembling step is deemed to be a matter of design choice, because such sequence of steps per se solves no stated problem", that the subject matter of claims 24 and 26 would have

been obvious because it is well known to inspect an assembled and painted products for quality control purposes; that the subject matter of claims 25 and 29 would have been obvious in view of Tomioka who teaches performing assembling operations as a final step; that the preliminary and non-preliminary drying step of claim 27 are met by the admitted prior art; and that the exact drying steps and stabilizing step set forth in claims 30-33 are deemed to be matters of design choice because they solve no stated problem.

Upon careful consideration, applicant respectfully traverses such rejection, and submits that claims 20, 26, 27 and 30-33 as now amended are clearly, patentably distinct over the applied art, based on the following.

Initially, applicant respectfully submits that the proposed hypothetical modifications of the relevant Background art discussed at pages 1-4 of the specification relative to select teachings of the Tomioka reference (assembly of an engine and functional parts to an automobile as the final step in the manufacturing process) is improperly based on a suggestion coming from the Examiner (as guided by impermissible hindsight gained from applicant's disclosure), rather than from any teaching or suggestion which may be fairly gleaned from the prior art. Although Tomioka generally discloses that fitting-out operations for mounting of parts such as an engine, tires, etc. to provide a completed vehicle may be performed after the application of a top coating (a final painting step) in an automobile manufacturing process, Tomioka's manufacturing process does not involve a step applying a strippable paint to a paint-finished surface. Rather, Tomioka's manufacturing process results in an automobile with a paint-finished surface, i.e., Tomioka's top coating is the finish paint. Similarly, although a finished product inspection may be performed at the end of a

conventional manufacturing process, such conventional process does not involve application of a temporary cover using strippable paint, liquid wax or a plastic film. Conversely, the use/application of strippable paint according to the present invention, and the use of strippable paint, rust preventing wax or a plastic film as a temporary cover according to the Background art discussed at pages 1-4 of the present specification, is a *supplemental* process/step to a conventional automobile manufacturing process such as disclosed by Tomioka. See, for example, Japanese Patent Laid-open No. 267171/1991 discussed at pages 1-2 of the present specification, and U.S. Patents 5,281,436 and 5,428,095 to Swidler, which were cited by the Examiner in parent application USSN 08/398,881.

Given the actual teachings of the Tomioka reference relative to his automobile manufacturing process and the actual teachings of the prior art regarding use of liquid wax, plastic film, and strippable paint as temporary protective covers for previously manufactured paint-finished objects, persons of ordinary skill in the art would not have considered it obvious to hypothetically modify/combine these conventional teachings such that a temporary cover of strippable paint is applied to a paint-finished surface of an automobile at an intermediate step of the manufacturing process (i.e., prior to a fitting-out operation of mounting an engine and functional parts to the vehicle or prior to the final inspection, because the prior art references do not provide any suggestion or motivation for doing so. At most, the prior art references teach or suggest the application of a temporary cover of strippable paint to a paint-finished surface of an automobile *subsequent* to such a fitting-out operation and *subsequent* to the final inspection of the manufactured automobile.

In this regard, applicant respectfully traverses the Examiner's allegation at the second-

to-last paragraph on page 4 of the Office Action that "...when the strippable paint is applied relative to the assembling step is deemed to be a matter of design choice, because such sequence of steps per se solves no stated problem", because the claimed method including application of the strippable paint prior to the assembling step does, in fact, overcome a disadvantage of the prior art, i.e., by applying the strippable paint to the paint-finished surface *prior* to the assembling step applicant has advantageously eliminated the conventional steps of applying an anti-scratch cover over the paint-finished surface prior to the assembling step and removing the anti-scratch cover after the assembling step. The claimed invention significantly simplifies and reduces the cost of the automobile manufacturing process by eliminating use of the anti-scratch cover, while otherwise protecting the paint-finished surface of the entire vehicle from dust, dirt, etc. which is invariably generated in the fitting-out or assembly step as discussed at pages 25-26 of the specification.

As the Courts have consistently held, differences between a claimed invention and a prior art structure/process cannot be considered as matters of "mere design choice" where, as in the present case, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify the prior art process to include the specific structure/steps in the specific arrangement as claimed, and where the claimed invention achieves significant advantages over the prior art. See In re Chu, 36 USPQ 2d 1089, 1094, 1095 (Fed. Cir. 1995), In re Gal, 980 F.2d 717, 25 USPQ 2d 1076 (Fed. Cir. 1992), and In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Similarly, the Courts have consistently held that an Examiner may not, because of doubt that the claimed invention is patentable, resort to speculation, unfounded assumption

or hindsight reconstruction to supply deficiencies in the factual basis necessary to establish prima facie obviousness under 35 USC §103. See In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). In the present matter, the proposed hypothetical modification/combination of the prior art references is nothing more than the speculation, unfounded assumption or hindsight reconstruction which the Courts have found to be insufficient to establish prima facie obviousness under 35 USC §103.

Further, applicant respectfully submits that the applied references do not disclose or in any way suggest a method of forming a protective film involving steps of preliminarily drying and non-preliminarily drying a strippable paint which has been coated on a paint-finished of the automobile in the specific manners as defined in claims 27, 30 and 33, or involving a step of stabilizing the coated strippable paint after it is coated on the automobile and prior to the preliminary drying step, as defined in claims 31 and 32. Mere drying of a strippable paint as generally discussed in the Background section of the present application, or a simple air-drying of a strippable paint at room temperature according to the Swidler references (U.S. Patent 5,281,436 and 5,428,095 cited in parent application 08/398,881) do not involve separate steps of sequentially stabilizing a coated strippable paint, preliminarily drying the stabilized paint and non-preliminarily drying of the paint as defined in claims 27 and 31, nor let alone the specific stabilizing step formed at room temperature and the specific preliminarily and non-preliminarily drying steps performed at elevated temperatures using IR radiation and hot air drying using first and second drying means, as defined in claims 27, 30, 32 and 33. The general teachings of the prior art references plainly lack any factual basis necessary to establish prima facie obviousness of the claimed features under 35

USC §103(a).

Again, applicant respectfully traverses the Examiner's allegations that the claimed features are obvious matters of "design choice" because such allegations are clearly not supported by the actual disclosures of the prior art references, which do not even remotely suggest the claimed features, and are otherwise plainly refuted by the fact that the claimed process steps achieve significant advantages over the conventional teachings, including superior quality temporary covers of the strippable paint. Applicant respectfully submits that the Examiner's allegations are, again, improper speculation, unfounded assumption or hindsight reconstruction, and insufficient to establish prima facie obviousness under 35 USC §103(a).

Based on the foregoing, applicant respectfully submits that the rejection of claims based on applicant's admitted prior art and the Tomioka reference under 35 USC §103 is overcome, and accordingly it is respectfully requested that such rejection be reconsidered and withdrawn.

New claim 37 is believed to be allowable over the references of record based on the foregoing arguments concerning the merits of claims 20, 27, and 30-33, as well as on the merits of the additional feature set forth in this new claim.

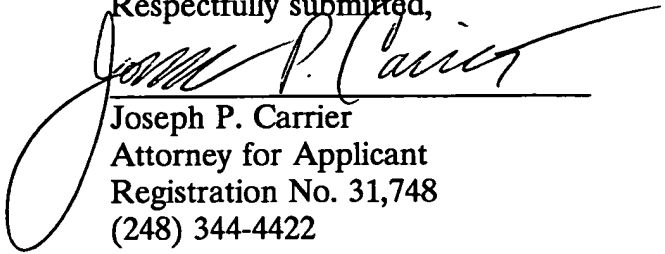
In conclusion, applicant has considered all of the references of record, and it is respectfully submitted that the invention as defined by each of the present claims is clearly, patentably distinct thereover.

The application is now considered to be in condition for allowance, and a notice to this effect is earnestly solicited.

Favorable reconsideration is respectfully requested.

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Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on February 2, 1998.

Dated: February 2, 1998  
JPC/jr



Jody Richmond